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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,259	08/09/2001	Jonathan William Adams	AUS920010647US1	4214

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EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,259

Applicant(s)

ADAMS ET AL.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment of 7/12/06 has been entered.

Claim Status

Claims 1-20 are active and are treated as followed.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful (1) process, (2) machine, (3) manufacture, or (4) composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 18, 19, 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the four statutory classes of invention as set forth in § 101 (i.e. (1) a process, (2) machine (apparatus), (3) manufacture (article of manufacture), or (4) composition of matter).

In the present case, method claim 18 or 1 are directed to "a method for designing an architecture for an e-business solution, said method comprising:

- a) developing a business description of the e-business solution;
- b) developing a pictorial presentation for the business description; and
- c) establishing a plurality of patterns within pictorial representation, the patterns being indicative of various implementations of the business description... of the e-business solution",

are merely a disembodied abstract idea and do not produce a useful, tangible, and concrete result.

The result of the instant invention is "establishing a plurality of patterns" (model or plan or set of forms or thing considered worthy of imitating) which are "being indicative of various implementations of the business description" whereby (1) the plurality of patterns and (2) pictorial representation serves as a documentation (or guide) for designing the architecture of the e-business solution. The "patterns" might be considered "useful" for serving as a guide for designing the architecture of the e-business solution (claim 18 only but not in claims 1-8), but this is merely intended use since the claim have no positive citation of designing the architecture of the e-business solution. However, § 101, test requires that the result be reproducible and repeatable to meet the tangible and concrete requirement. See *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Circuit 2000). In the instant case, it's not clear how steps (a)-(c), which are based on patterns within pictorial representation, the patterns being indicative of various implementations of the business description, to serve as a documentation (or guide) for designing an architecture for an e-business solution. What are the implementations of the business description? There is nothing concrete about the "implementations of the business description" which can vary which the type of business, desired result, implementation system, etc. There is no citation in the specification of how these steps are carried out and no example has been cited. The claim is broad to include the developing and establishing steps by human being which

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produces results which are subjective and irreproducible. This fails to meet the test that the result has to be concrete to meet the § 101 test.

Moreover, there is no physical transformation of anything to another state or thing even though this is dispositive. Therefore, claims 1-20 are thus drawn to the abstract idea of developing some guidelines for designing the architecture of the e-business solution using business description and a plurality of patterns, rather than to a practical application of the idea as required by 35 U.S.C. § 101.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.**

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim fails to include at least one example, or demonstration to show how the process of claim 18 works. For example, what is an architecture of an e-business solution and how this architecture of the e-business solution can be derived from the features of the e-business solution? The examiner has read the specification at least twice and has no clear understanding of what are the claimed invention. The examiner has give this case to another examiner

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who has a degree in MIS and an MBA and this examiner has the same problem. The specification merely explains the claims but contains no examples of how the inventions work.

5. Claims 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In claim 18, line 7, the phrase “whereby the pictorial representation and plurality of patterns serves as a guide” is vague. The term “serves” should be corrected to “serve”. It’s not clear what this phrase means “the patterns being indicative of various implementations of the business description whereby the pictorial representation and plurality of patterns serve as a guide for designing the architecture of the e-business solution”. What are the implementations of the business description? There is nothing concrete about the “implementations of the business description” which can vary which the type of business, desired result, implementation system, etc. Applicant needs to cite an example of what this means.

2) Claims 19-20 are rejected for the same reasons set forth in claim 1 above.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 10-17 (product), 20 (product) are rejected under 35 U.S.C. 102(e) as being anticipated by CALVER (US 2001/0032092).

As for independent product claims 10, 20, CALVER discloses a computer program product in a computer readable medium {see claims 21, 31}. As for the rest of the limitations in claims 10-17, 20, they have no patentable since there are no citation in the claim that "the computer readable code (or instructions) when being executed by a processor (computer) causing said processor/computer to perform the method of: (a), (b), and (c.)". In other word, there are no processor/computer connected to the code or involved in the body of the claim to carry out the method steps, so these are merely code.

As for dep. claims 11-17 (part of 10), they are rejected for the same reasons set forth in claim 10 above.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 18, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over CALVER in view of GRYPHON et al (US 6,233,537).

As for independent method¹ claim 18, GRYPHON et al discloses a workflow modeling of business applications composed of multiple plan elements having pictorial representation and business rules (patterns) to control the business application/actions {see Figs. 1-5}. GRYPHON et al fairly teaches the claimed invention except for dealing business application concerning e-business solution. CALVER is cited to teach a method for designing an architecture/format for an e-business solution to provide the benefits of providing valuable financial, marketing, and business development information to small business {see [0016, 0003, 0010, 0052, 0054, 0081]}. It would have been obvious to modify the teachings of GRYPHON et al by including application dealing e-business solution as taught by CALVER for at least one of the benefit cited above.

As for independent apparatus¹ claim 19, which is an apparatus to carry out the method of claim 18 above, “means for “ instead of “step of”, it is rejected for the inherent apparatus to carry out the method steps of 18 by GRYPHON et al /CALVER above.

As for independent product¹ claim 20, which is the computer-readable medium related to the method of claim 18 above, it is rejected over the inherent computer-readable medium in GRYPHON et al /CALVER above which is used for the rejection of method claim 18 above.

Response to Arguments

10. Applicant's arguments filed 7/19/06/05 have been fully considered but they are not persuasive.

(1) With respect to the rejection of claim 18 over 101 rejection, applicant's comment on page 12, 1st paragraphs, that claim 19 requires "means for" per 35 U.S.C. 112, p6 and claim 20 requires computer program code are noted, however, none of these limitations are in claim 18.

(2) With respect to the 112, 1st paragraph, applicants' response is insufficient to overcome the rejection since applicant has not shown/demonstrated how the specification is clearly described in a way that enables one skilled in the art to make and/or use the invention. Applicants have not cited an example of how the claimed invention or method claim 18 works. What are the implementations of the business description? There is nothing concrete about the "implementations of the business description" which can vary which the type of business, desired result, implementation system, etc. The specification merely recites the language of the claim several times with some sporadic related ideas. Applicants' amendment of claims 18-20 are solely to clarify the invention but these amended claims are still insufficient to overcome the rejections.

(3) With respect to the 112, 2nd paragraph, applicants' comment that the definiteness of the language is analyzed, not in a vacuum, but in light of the teachings of the disclosure as the disclosure would be interpreted by one of ordinary skill in the art, and no citation or example of how the claim is carried out is needed, this is not found persuasive for the same argument as indicated above, how the specification is clearly described in a way that enables one skilled in the art to make and/or use the invention.

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(4) With respect to the 102(e) rejections of claims 10-17 as anticipated by Calver, the rejection is maintained because there are no citation in the claim that "the computer readable code when being executed by a processor (computer) causing said computer to perform the method of (a), (b), and (c.)". In other word, there are no processor/computer connected to the code or involved in the body of the claim to carry out the method steps, so these are merely code, thus having no patentable weight.

(5) With respect to the 103(a) rejections of claims 18, 19, 20, applicant's comment that CALVER /GRYPHON et al fails to teach the establishing of patterns (models) within the pictorial representation, this is not found persuasive in view of GRYPHON et al, col. 3, lines 5-10, "graphical notation that can be used to represent business process knowledge and the corresponding business information that comprises the business model.", col. 6, under "How to use Visual BML", col. 9, line 62 to col. 10, lines 16. Note that the rejections are based on CALVER /GRYPHON et al and not GRYPHON et al alone. Applicants' comment that CALVER is merely cited to teach the computer readable code is not correct.

Allowable Subject Matter

11. Claims 1-8, and 9 are allowed.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

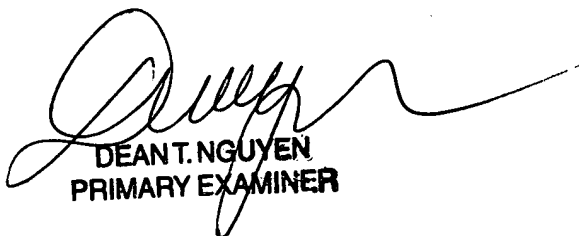
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
October 1, 2006


DEAN T. NGUYEN
PRIMARY EXAMINER